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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,507	09/09/2003	Mark A. Reiley	9448.17205-CIP DIV 11	1793
21971	7590	08/10/2006	EXAMINER	
WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 94304-1050			ISABELLA, DAVID J	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 08/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,507

Applicant(s)

REILEY, MARK A.

Examiner

DAVID J. ISABELLA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/05/6/05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Status of the Claims

Claims 1-49 have been canceled. New claims 50-54 filed herewith are copies of claims 62- 66 from the parent application of the present case co-pending Patent Application Serial Number 10/615.727. Applicant correctly identified that the Office Action mailed August 10, 2005 for Patent Application Serial Number 10/615,727 indicated that claims 62-66 were allowable. However, in view of a new search and review of the claims, the indication of the allowability of the claims has been withdrawn and a new rejection to the claims follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50-52,54 are rejected under 35 U.S.C. 102(b) as being anticipated by Fitz (Re 36758).

Fitz discloses a prosthesis for the replacement of at least a portion of the bone of a facet located on a mammalian vertebra comprising: a surface that articulates with another facet surface; a fixation portion that is configured for implantation in an interior bone space of said vertebra, said surface being connected to said fixation portion. See figures 3 and 4. Note prosthesis portion 50 and 40 with fixation portions 58,60 and 48.

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Claim 51, see fixation portions 58,60 and 48 adapted to be fitted into the interior bone space of a pedicle.

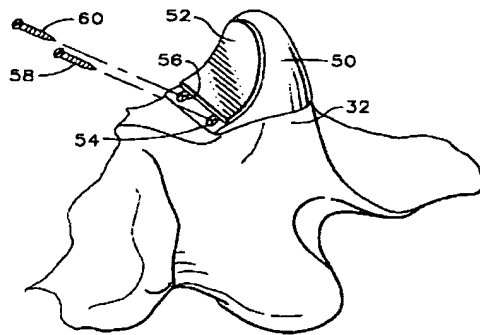


FIG. 3

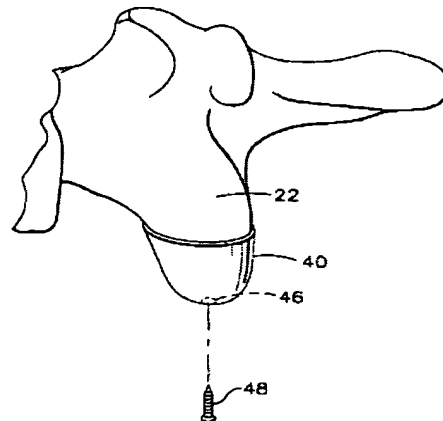


FIG. 4

Claim 52, see porous coating 44 and 66.

The adhesion of either the superior component 40 or the inferior component 50 or both to the underlying bone may be enhanced by applying a porous coating 44 and 66, respectively, to the inner surface of the superior component 40 or to the inner surface of the inferior component 64. In the preferred embodiment of this invention the porous material is of the same material as the component to which it is applied. There are many methods known to those skilled in the art for producing the porous coating. For example, the porous coating can be made up of small spherical particles that are attached to the interior surface by methods well known in the art. The porous coating will allow for bony ingrowth to occur and to firmly attach the component to the underlying bone.

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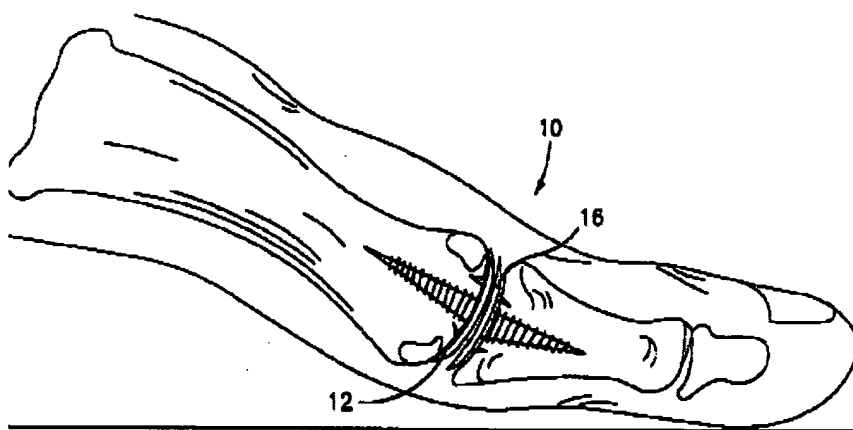
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Claim 54, see column 2, lines 3+.

Each component of the device of this invention is made of a biocompatible material such as stainless steel, unalloyed titanium, or a titanium-aluminum alloy. The elongated side of the inferior component has a low coefficient of friction so that it offers minimal resistance to the movement of the superior component. This may be accomplished by coating the outer surface of the elongated side with either polished chrome or a friction reducing material such as a medical-grade high density polyethylene.

Claims 50-52,54 are rejected under 35 U.S.C. 102(b) as being anticipated by Vitale (5683466)

Vitale discloses a prosthesis for the replacement of at least a portion of the articular surface of a bone comprising: a surface that articulates with another complimentary surface; a fixation portion that is configured for implantation in an interior bone space, said surface being connected to said fixation portion. See figure 2. Note prosthesis portion 26 and 20 with fixation portion 22.

**FIG. 2**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitz (Re 36758) or Vitale (5683466) as applied to claim 50 above, and further in view of Davidson (5348026) or Bowman et al (4950270).

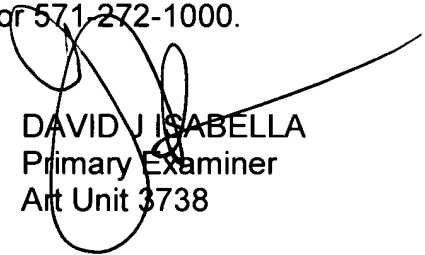
Davidson and Bowman teach the concept for coating a osteo-screw with a coating of osteoinductive substance to reduce the tendency for stress concentration and promote new tissue attachment. To coat the screw of Fitz or Vitale with an osteoinductive material to reduce the likelihood of failure of the fixation of the implant would have been obvious to one with ordinary skill in the art from the teachings of Davidson or Bowman et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. ISABELLA whose telephone number is 571-272-4749. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DAVID J ISABELLA
Primary Examiner
Art Unit 3738

DJI
7/26/2006